Section IV:
AMENDMENT UNDER 37 CFR §1.121
REMARKS

Summary of Telephone Interview

On August 31, 2004, Examiner Basehoar and applicant's agent Robert H. Frantz held a telephone interview at the applicant's agents request in order to discuss a proposed amendment as provided by applicant's agent in advance of the interview.

Three differences between our invention and the cited references were discussed:

(a)   that our invention provides the interest terms to the web browser and web browser extensions (e.g. plugins, scripts, etc.), not to a server, where they are used by the web browser and extensions to provide interest term highlighting, searching, etc., without the need to access a specific server or web page;

(b)   in one embodiment, our invention collects the interest terms from the user via a series of questions, not just a long list of check boxes; and

(c)   in another embodiment, our invention collects the interest terms from the user via an expandable and collapsible check list such that the user display space is efficiently used, and such that the user is not distracted by selectable sub-categories and options which are categorically not of interest.

Examiner Basehoar suggested a wording change in the proposed amendment to the independent claims, which as been implemented in this formal reply. Examiner agreed that these changes appeared to be sufficient to overcome the cited art, but that he would need to consider the final formal amendment, and perform any supplemental searching that may be needed in view of the formal amendment.

Objections to the Claims

In the Office Action, the examiner has objected to Claims 3 and 10, and suggested wording change to improved the clarity of the claims. The examiner's suggestion has been adopted in the present amendment.

Claim Rejections

In the Office Action, the examiner has rejected claims 1, 3 - 8, 10 - 15, 17, and 19 - 21 under 35 U.S.C. §102(b) for lack of novelty as being anticipated by U.S. Patent Number 5,983,227 to Nazem, *et al.* (hereinafter "Nazem"). Claims 1, 8, and 15 are independent claims, and Claims 7, 14 and 21 have been canceled by the present amendment.

In the Office Action, the examiner has rejected claims 2, 9, and 16 under 35 U.S.C. §103(a) as being unpatentable over Nazem in view of Chris Wenham's "My Yahoo" document, published online (hereinafter "Wenham"), and rejected claim 18 over Nazem in view of Free Online Dictionary of Computer Terms definition of "flat file" (hereinafter "FOLDOC").

In comparison to the two references, the Nazem patent and the Wenham patent, our invention differs in at least three considerable ways from either of these systems or methods:

(a)   Our interest term list is created by a web browser (not by a server process), and is preferably stored by the web browser (not by a server), so that the interest terms are available to extended functions of the web browser without the requirement to interact with a specific web server.

Both Nazem and Wenham deal with a server-based process where a specific server (e.g. the My Yahoo server) stores a user's interest list. The Nazem or Wenham interest list would not be accessible to a user's web browser plug-in, as it is only described as being accessible by the server functions which generate custom web pages.

As such, with our invention, the user's interest terms may be used and applied to any web site viewed with the user's web browser, but the Nazem and Wenham interest term list can only be applied to information gathered by the My

Yahoo server. The present amendment to our claims specifies this web browser-related implementation, which is not taught or suggested by Nazem or Wenham.

(b)   In one embodiment as claimed in claims 2, 9 and 16, our invention queries the user through a series of questions in the conversational format of an interrogative sentence, e.g. an actual question such as "Are you interested in Sports?" (pg. 13, lines 5 - 20). This provides a more conversational type of query, rather than a simple list with checkboxes. For example, using our conversational model of query to the user, the user can first be simply asked "Are you interested in Sports?" without displaying a long list of sports categories (e.g. Football, Basketball, etc.) and specific sports (e.g. College Football, Pro Football, etc.). If the user answers "No", then the "conversation" proceeds to the next, non-Sports related question, such as "Are you interested in Politics?".

Both Nazem's and Wenham's systems disclose only the use of lists of items, such as lists with checkboxes. Wenham's paper does not actually disclose use of interrogatory, conversational queries, but only mentions that a user "tells My Yahoo" what his or her interests are. Nazem discloses only minimal information about their "preference editing", which generally involves selecting "templates" of page sections which each have certain types of information in them (e.g. sports, finance, etc.)

As such, with our invention, the user is "questioned" or "interviewed" to determine his or her interest terms, wherein negative responses avoid and minimize display of information that is irrelevant to the user. Nazem's and Wenham's systems, however, display the irrelevant choices such as sub-categories and detailed choices, whether the user has interest in the top level subject or not.

(c)   In another embodiment of our invention as claimed in claims 3, 10 and 17, we minimize the display of irrelevant sub-categories and detailed choices to the user by using an "expansive master list" (pg. Pg. 13, line 20, and pg. 15, line 10) In this, we mean "expandable", which is one synonym for "expansive". We have also provided examples of our master list which "explodes" and "collapses" for

displaying sub-categories and detailed choices.

Similar to the discussion in (b) above, neither Nazem or Wenham disclose use of such an expandable list, but rather show entire lists whether the user cares about the top-level subject or not.

. To avoid misinterpretation of our use of "expansive" as "very large" in our specification (the opposite of our objective), we have amended the claims 3, 10, and 17 to employ the term "expandable".

Further, we have amended our independent claims to specify that our user dialog is a sequential prompting for input during which the user is queried as to interest in general categorical terms with suppression of sub-category and specific terms unless the user's response is affirmative, responsive to which the user is queried as to interest in one or more sub-categories and one or more specific terms associated with the general categorical terms of interest. This more generic recitation embodies the variants of claims 2, 3, 9, 10, 16, and 17.

We request reconsideration and withdrawal of all rejections in view of the present amendment for the following reaons:

1.   The cited reference, Nazem's patent, does not properly anticipate the claimed invention in view of the present amendment, as it fails to disclose all the claimed steps, elements or limitations.   MPEP 2131 states:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM *(capitalization emphasis found in original text)*

2.   The proposed Nazem-Wenham combination does not teach all the claimed elements, steps, or restrictions. MPEP §2143.03 states:

> **All Claim Limitations Must Be Taught or Suggested.** To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.

3.   Motivation or suggestion to make the examiner's combination or modification of the references is not found in the cited art. MPEP §2143.01 states:

> Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

With respect to the rejections of claims 2, 9, and 16, examiner has reasoned that there is a relationship between Wenham's document and the Nazem patent. Wenham, however, refers generically to "My Yahoo!" service, as does the Nazem patent, but no further reference is made by Wenham to the Nazem patent disclosure itself. It is therefore improper to import the disclosure from Wenham into Nazem's patent disclosure, if Nazem makes no suggestion to be modified to include functionality as described by Wenham.

With respect to the rejection of claim 18 in view of the FOLDOC definition of "flat file", examiner has reasoned that motivation to include a flat

file in the implementation of Nazem would have been obvious because flat files

are more portable between operating systems, and that flat files are more efficient

to transfer than files which include structural data.   However, Nazem is silent as

to the use of "flat files", and teaches to use of "memory mapped" files for quick

recovery and access to the data with minimal user wait:

> Shared memory 212 is organized as a set of <u>memory mapped</u>
> <u>files</u>. With memory mapped files, the operating system
> maintains the data in permanent storage, but permanently
> caches the files in shared memory 212. This allows for <u>quick</u>
> <u>recovery</u> should a page server crash, since all of the shared
> memory can simply be reloaded from the permanent storage.
> This is a great feature from a user convenience standpoint,
> since the user will never be faced with a situation where they
> have to wait for a server to rebuild a page for them by
> querying the various data providing servers, such as sports
> server 230, stock server 232 and news server 234. As should
> be apparent from this description and FIG. 2, page generator
> 210 can generate custom front page 218 much <u>more quickly</u>
> <u>using shared memory</u> 212 as compared with using servers
> 230, 232, 234 and page template 202. One reason for this is
> that the time it takes to retrieve data from shared memory 212
> does not appreciably increase relative to the bandwidth delay
> time when more data is retrieved. For example, if stock server
> 232 were queried for each individual stock quote, a page with
> fifty stock quotes <u>might take ten times as long</u> to generate as
> a page with five stock quotes. (Nazem col. 4, lines 3 - 23,
> emphasis added)

4.   The Nazem reference teaches away from the examiner's proposed combination as
described in the forgoing quote from Nazem regarding memory mapped files.
MPEP §2145 states:

> It is improper to combine references where the references teach away from their
> combination.

Conclusion

Applicant requests consideration of these remarks in view of the present amendment, and
allowance of the claims as amended.

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